

# RESPONSE TO FINAL OFFICE ACTION

APPLICANT: Akira Osawa; SERIAL NO.: 09/293,509; AU: 3713

FILED: April 15, 1999; EXAMINER: White, C.; ATT'Y. DKT.: RM.HPN

a controller coupled to said variable display for causing said variable display to display the graphical information; and

*B*  
*Longi*  
a secondary display having a display area for displaying a number of identical images, wherein the identical image is associated with one of a plurality of predetermined display states as a result of the principal game, the display of the image on said secondary display corresponding to a history of each predetermined display state of the principal game and an indication of a one of the plurality of principal game playing states that has a likelihood of winning a subsequent principal game.

## In the Specification:

~~Page 2, line 10, delete "respectively."~~

~~Page 15, line 7, delete "inning" and insert therefor -- winning --.~~

~~Page 15, line 9, delete "inning" and insert therefor -- winning --.~~

~~Page 26, line 9, delete "by" and insert therefor -- on --.~~

## R E M A R K S

Amendments are presented herein to improve the form of the subject application and in response to the Examiner's comments in the above-identified Office Action.

### ***Double Patenting***

The Examiner states that the non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. The Examiner directs Applicant's attention to

*In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

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USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

The Examiner continues by stating that a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. The Examiner also notes 37 C.F.R. § 1.130(b). According to the Examiner, effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. According to the Examiner, a terminal disclaimer signed by the assignee must comply fully with 37 C.F.R. § 3.73(b).

Claims 1-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/268,960 (RM-HPM). The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant claimed invention are drawn to a gaming machine that has a primary game and a secondary game that achieves the same objective as the claimed invention of copending Application No. 09/268,960. The Examiner concedes that the claim language of the instant application is not exactly the same as that of Application No. 09/268,960. However, the Examiner believes that the invention of the instant application achieves all the same functions as the instant invention of Application No. 09/268,960.

The Examiner has characterized the present rejection as a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant will provide, at such time as allowance herein is indicated, an appropriate Terminal Disclaimer that will address and overcome the Examiner's obviousness-type double patenting rejection.

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## *Claim Rejections- 35 U.S.C. § 112, Second Paragraph*

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out with particularity and claim distinctly the subject matter that Applicant regards as the invention.

The Examiner states that the newly amended claim feature of “the display of the image on said secondary display corresponding to a likelihood of winning the principal game” is not clear to the Examiner. According to the Examiner, the specification seems to indicate that the images in the principal game are placed in the secondary game. Thus it appears to the Examiner that the likelihood of winning the secondary game corresponds to the images displayed in the primary game. The images displayed in the secondary game, in the instant claimed invention, are triggered by the images displayed in the primary game. The Examiner therefore questions how the instant invention achieves the aforementioned, newly added claim feature. The Examiner states that Applicant has indicated in his remarks that this feature is taught on page 26, lines 6-15 of the specification. The Examiner has read this section of the instant disclosure, but this feature is not clearly explained in the Examiner’s view. This area of the specification appears to the Examiner to indicate that the player can determine the likelihood of winning the secondary game by viewing the images that appear on the primary game.

Applicant respectfully notes that the specification states in a number of locations therein that the secondary game is responsive to the principal game. For example, the specification states at page 3, lines 4 to 7:

... The secondary game is effected in a variable, or secondary, display that variably displays a plurality of symbols that are used in the principal game, whereby the player achieves a feeling of high excitement to win the principal game, the feeling of expectation being enhanced by the secondary game which proceeds in response to a predetermined state of the principal game (Emphasis added)

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At lines 13-20 of page 3 it is stated:

... Moreover, the secondary display displays the image when the playing of the principal game results in one of a plurality of predetermined principal game playing states.

The predetermined state includes, for example, a predetermined display that is shown when the variation action (e.g., the rotating reels) of the variable display is stopped. In other words, a predetermined winning combination of symbols (winning pattern) of the principal game and a combination of symbols (pattern) are predetermined to cause a particular symbol image to be shown on the secondary display. (Emphasis added)

At page 5, lines 19 to 23, the specification states:

... The secondary game has an aspect of a "race game," as mentioned above, and additionally provides an indication of the history of appearance of the predetermined states of the primary game, as mentioned above. The player can easily recognize what kind of the predetermined state furthers the likelihood of winning or losing the secondary game by observing the area or number of the symbol image indicated.

Clearly, the specification specifies that the secondary display is responsive to a "predetermined state" of symbols is displayed on the principal display.

The fact that the execution of the secondary game is responsive to a win of the primary game is specified clearly at page 16, lines 9 to 12 of the specification, wherein it is stated that:

In this case, the secondary game is executed only when one of the patterns of the principal game performed by the variable display (i.e., combinations of the symbols such as "7-7-7" and others) is one that has been predetermined from all patterns to execute an indication for the secondary game stands in the central winning line in display windows 3L, 3C, 3R as stop pattern.

With respect to the aspect of the present invention whereby the symbols displayed in the secondary display "[correspond] to a likelihood of winning the principal game," as claimed, it is noted that in the previously recited excerpt from the specification at page 3, lines 17-20 it is made clear that "a predetermined winning combination of symbols (winning pattern) of the principal game and a combination of symbols (pattern) are predetermined to cause a particular symbol image to be shown on the secondary display." Thus, the secondary display, which displays information responsive to the prior wins of the primary display, is "*a display of a record of the history of predetermined states that have resulted during the playing of the principal game.*" (See, page 4, line 6-7) More to the point, in addition to providing a display for a game that can be won by the player,

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the secondary display additionally provides historical data that can be useful to the player to help win the primary game. Thus, “[a] player would endeavor to stop the variation action at a winning state that is profitable for the secondary game, while simultaneously endeavoring to win the principal game.” (See, page 4, lines 21 to 23).

The foregoing is summarized in the Detailed Description portion of the specification, particularly, page 19, line 18 to 22, wherein it is stated that:

Further, to the extent that the player plays the principal game repeatedly, the symbol images of the secondary game continue to be indicated until the secondary game is completed. Accordingly, the player can see from the secondary display the history of appearance of each winning state and also recognize what kind of winning pattern of the principal game is close to causing a win of the secondary game.

It is respectfully asserted that the specification clearly describes the secondary display as providing information on the likelihood of winning the primary game, and there is further provided a complete description of the manner by which symbols that correspond to predetermined states that appear on the principal display are also displayed on the secondary display to play the secondary game and to provide the information on the likelihood of winning the primary game. Moreover, the detailed description provides a complete description of the manner in which the states of the principal game are determined and the determination whether to execute the secondary game (see, Figs. 4 and 5, and accompanying description on page 12, line 5, *et seq.*).

The foregoing notwithstanding, Applicant has amended independent claim 1 to specify with greater clarity that the “display of the image on said secondary display ... [corresponds] to a history of winning principal game playing states and [provides] a corresponding indication of a one of the plurality of principal game playing states that has a likelihood of winning a subsequent principal game.” This amendment does not add new matter and is directed toward placing independent claim 1 in allowable condition. In view of the foregoing, it is believed that the Examiner’s rejection of claim 1 under 35 U.S.C. § 112, second paragraph, has been overcome.

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## ***Claim Rejections - 35 U.S.C. § 102(b)***

Claims 1-8 and 14 stand rejected under 35 U.S.C. § 102(b) as specifying subject matter considered by the Examiner to be anticipated by the Marnell, II (5,393,057) or Farrell (GB 2242300A) references.

### **CLAIM 1**

Regarding claim 1, the Examiner states that the Marnell, II or Farrell references disclose a variable display for displaying graphical information corresponding to graphical elements necessary for a principal game; a controller for causing the variable display to display the graphical information; and a secondary display for displaying an image that is necessary for playing a secondary game that is different from the principal game, the secondary display displaying the image when the principal game results in one of a plurality of playing states. The Marnell, II or Farrell references are further considered by the Examiner to teach that certain symbols from the primary game are placed in the matrix of the secondary game. These symbols, according to the Examiner, indicate symbols from winning patterns in the primary game (Marnell, II - col. 2, lines 35-51; col. 3, lines 1- 9; Fig. 2; Farrell - Fig. 1, #57).

As previously noted during prosecution of the present application, the Marnell, II reference describes a gaming apparatus that provides a principal game in the form of a slot machine game or a poker game. With each iteration of the principal game, such as a poker hand or stop action of a set of slot machine reels (column 2, line 47), an automatic entry is made into a secondary bingo (matrix) game (column 2, lines 49-50).

The Farrell reference describes a "fruit" machine (a slot machine with reels having fruit graphics thereon) with a second display in the form of a grid or matrix. The particular symbols that appear on the first or second reels when the reels are stopped are selectively presented in corresponding positions of the matrix. Prizes are awarded for completed lines in the matrix.

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Applicant respectfully argues once again that the Marnell, II and Farrell references are representative of the prior art arrangements discussed in the prior art section of the present specification. More particularly, these reference cause placement of a graphical symbol on the matrix-style secondary display in response to the particular symbol that is presented on the winning line of the principal game. In this regard, the present specification states at page 2, lines 5-23:

One known approach to alleviating the aforementioned problem of the gaming machine is to provide a gaming machine having a variable display and a further display, which such as a liquid crystal display or the like, by which a secondary game that is different from the principal game by the reels is played. One known approach employs a virtual race game wherein three kinds of special symbols are established for the principal game and three kinds of secondary images corresponding respectively to the three kinds of special symbols, respectively, are established for the secondary game. Whenever one of the special symbols stands on a winning line, the secondary image corresponding to that special symbol is moved on the liquid crystal display whereby it competes with the other secondary images. That is, the frequency of appearance of each special symbol causes its corresponding secondary image to move along the further display at a corresponding rate. The secondary images appear therefore to race, and when one of the secondary images reaches a predetermined position, the player wins an award.

In the known gaming machine described hereinabove, however, the secondary game proceeds simply when a special symbol of the principal game stands on the winning line. In other words, the secondary game proceeds with no relation to the result of the principal game. Accordingly, when a player endeavors to win the principal game, i.e., by the rotatable reels, the secondary game oftentimes proceeds without being noticed by the player. The player therefore does not achieve a sense of relationship between the principal game and the secondary game, and the player's enthusiasm to play to the gaming machine is not raised. (Emphasis Added)

In the present invention, however, and as previously noted, the secondary game is related to the principal game, in that the playing of the secondary game will provide indication of the likelihood of winning the principal game. This is recited in the present specification at page 26, lines 6-15, as follows:

As described above, the secondary game played on the secondary display screen is separate from the variable display that displays the principal game, but is related to the result of the principal game, thereby enhancing the player's interest in continuing to play the entire game. The secondary game by the secondary display screen proceeds while indicating histories of the (winning) states displayed in the past by the variable display. Therefore, the player can know whether the completion of the secondary game is near or not. Also, it is easy for the player to know at glance what kind of (winning) pattern has to be displayed in the principal game for completion of the secondary game so that the player may play the game with high interest and expectation. The player can endeavor to win the principal game by paying attention to the progress of the secondary game, thereby greatly elevating the player's interest in the game. (Emphasis Added)

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The Marnell, II and Farrell references do not teach or suggest any interrelationship between the principal and secondary games wherein the principal game can be won by reference to the secondary game. As previously noted, in each of the applied references, the result of the principal game is applied to cause an entry into a matrix game, but there is no teaching that the result of the matrix game can be applied to anticipate a win in the principal game. In the Farrell reference, the secondary display displays symbols that correspond to specific symbols that are present in the principal game when the reels of the principal game are stopped, not game states that correspond, for example, to winning states or to states that represent a determinable likelihood of winning. In the Marnell, II reference, at column 9, lines 9 to 15, it is stated that "when gaming apparatus 21b is a stand-alone machine it may be desirable to prevent duplication of the input in a single row or bingo winning pattern. Microprocessor 69 and memory 71, therefore, can be programmed to prevent the entry of three-of-a-kind in the same row more than once in a potentially winning pattern." Thus, in the gaming machine of Marnell, II, the image is not always displayed in the block each time. Accordingly, the gaming machine having a secondary display as specified in new claim 15 is not taught or suggested in the Marnell, II and/or Farrell references. Moreover, the Marnell, II and Farrell references do not teach "a gaming machine wherein a player can earn a profit or receive an award that is increased in response to a secondary game that is played supplemental to a principal game." See, specification, page 3, lines 2-4.

With respect to independent claim 1, Applicant has amended this claim to specify subject matter that is neither taught nor suggested by the Marnell, II and Farrell references. More specifically, amended independent claim 1 specifies that there is provided:

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...

a secondary display for displaying an image, the image displayed by said secondary display being necessary for playing a secondary game that is different from the principal game, said secondary display displaying the image when the playing of the principal game results in one of a plurality of predetermined principal game playing states, the display of the image on said secondary display corresponding to a likelihood of winning the principal game. (Emphasis added)

The Examiner has maintained the present rejection in this Final Office Action on the following grounds:

- it is not clear what Applicant means by the claim language added to claim 1 in the response to the initial action.

In regard of the foregoing, Applicant notes with respect to the Examiner's first ground that the previously added claim language (*i.e.*, the display of the image on said secondary display corresponding to a likelihood of winning the principal game) has been clarified herein. More specifically, it is noted that Applicant has set forth hereinabove a number of excerpts from the specification identifying the secondary display as providing to the player data, derived from the results of prior wins of the principal game, and which is useful not only to play the secondary game, but also to provide information relating to the combination of game elements most likely to constitute a future win of the principal game.

In view of the foregoing, the meaning of the previously added claim language, and the support therefor in the specification, should be clear.

- Farrell keeps track of the symbol history of the primary game by placing certain symbols from the primary game in the matrix of the secondary game, whereby the player can predict certain "winning" patterns of the primary game by viewing the symbols placed in the secondary game matrix.
- Marnell II also teaches that certain poker hands (Fig. 1) or reel symbols (Fig. 2) of the primary game trigger the display of corresponding symbols in the secondary

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(Bingo) game such that the player is able to view the secondary game to see the winning symbols that were displayed in the primary game.

As previously stated during prosecution of the present case, the Marnell, II and Farrell references do not teach or suggest any interrelationship between the principal and secondary games wherein the principal game can be won by reference to the secondary game. As previously noted, in each of the applied references, the result of the principal game is applied to cause an entry into a matrix game, but there is no teaching that the result of the matrix game can be applied to anticipate a win in the principal game. In the Farrell reference, the secondary display displays symbols that correspond to specific symbols that are present in the principal game when the reels of the principal game are stopped, not game states that correspond, for example, to winning states or to states that represent a determinable likelihood of winning. Moreover, the Marnell, II and Farrell references do not teach "a gaming machine wherein a player can earn a profit or receive an award that is increased in response to a secondary game that is played supplemental to a principal game." See, for example, specification, page 3, lines 2-4.

- the systems of Marnell II and Farrell are considered by the Examiner to teach the same features as the instant claims.
- Applicant's assertion that the Marnell II or Farrell references do not teach or suggest "any interrelationship between the principal and secondary games wherein the principal game can be won by reference to the secondary game," or that the Marnell II or Farrell references do not teach "a gaming machine wherein a player can earn a profit or receive an awarded that is increased in response to a secondary game... , are not in the claims.

Applicant respectfully asserts that the Marnell II and Farrell references do not teach the same features as the instant claims. For example, claim 1, as amended, specifies as follows:

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...  
a secondary display for displaying an image, the image displayed by said secondary display being necessary for playing a secondary game that is different from the principal game, said secondary display displaying the image when the playing of the principal game results in one of a plurality of predetermined principal game playing states, the display of the image on said secondary display corresponding to a likelihood of winning the principal game.

As stated, the Marnell, II and Farrell references do not suggest that the image shown in the secondary display is indicative of a “predetermined principal game playing state,” or that “the image on said secondary display ... [corresponds] to a likelihood of winning the principal game.” Accordingly, it is respectfully asserted that amended independent claim 1 specifies subject matter not taught or suggested by the Marnell, II and Farrell references, and accordingly the Examiner’s rejection of claim 1 under 35 U.S.C. § 102(b) has been overcome.

## CLAIMS 2-4

Regarding claims 2-4, the Examiner states that the Marnell, II or Farrell references further disclose the secondary display indicating symbol images that correspond to a respectively associated one of the principal game playing states (Marnell II - Abstract; Farrell - Fig. 1, #6, #2; #57).

## CLAIMS 5-7

Regarding claims 5-7, the Examiner states that the Marnell, II or Farrell references further disclose providing an award to a player when the secondary display screen satisfies a predetermined condition (Marnell II- col. 7, lines 7-14; Farrell- Fig. 1, #9 and page 9, lines 25-34).

## CLAIM 8

Regarding claim 8, the Examiner states that the Marnell, II or Farrell references further disclose the resetting of the secondary display (Marnell II- col. 7, lines 25-34 and col. 6, lines 23-27; Farrell- page 12, lines 20-25).

## CLAIM 14

Regarding claim 14, Marnell II is considered by the Examiner to disclose that the primary games are a slot game and a poker game (Fig. 1 and Fig. 2).

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With respect to dependent claims 1-8 and 14 which are also rejected by the Examiner under 35 U.S.C. § 102(b), these claims contain all of the limitations of amended independent claim 1, and accordingly are allowable for the same reasons stated above.

### *Claim Rejections- 35 U.S.C. § 103(a)*

#### CLAIMS 9-12

Claims 9-12 stand rejected under 35 U.S.C. § 103(a) as specifying subject matter considered by the Examiner to be obvious over Marnell, II (5,393,057) or Farrell (GB 2242300A).

Regarding claims 9-12, the Examiner states that the Marnell, II or Farrell references disclose all the elements of the claims as discussed above. While Marnell II is considered by the Examiner to teach the clearing of all of the display areas, the Examiner concedes that Marnell II is silent on disclosing the clearing of a single display area. The Farrell reference is considered by the Examiner to disclose the resetting of the display screen or the holding of some of the display areas for another game (p. 12, lines 20-30). The Examiner continues by stating that it would be an obvious design choice to clear either one or all areas according to whether or not the player wanted to maintain some symbol positions in order to increase the player's chances of winning in subsequent games. Therefore, the Examiner concludes that it would have been obvious to include this feature in the systems disclosed in the Marnell II or Farrell references.

With respect to dependent claims 9-12 which stand rejected by the Examiner under 35 U.S.C. § 103(a), these claims contain all of the limitations of amended independent claim 1, and accordingly are allowable for the same reasons stated above.

#### CLAIM 13

Claim 13 stands rejected under 35 U.S.C. 103(a) as specifying subject matter considered by the Examiner to be obvious over Marnell, II (5,393,057) or Farrell (GB 2242300A) in view of Wilson, Jr., *et al.* (6,004,207) or Adams (5,848,932).

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The Examiner states that regarding claim 13, the Marnell II or Farrell references disclose all of the limitations of the claim as discussed above. The Examiner concedes, however, that the Marnell II or Farrell reference fail to disclose a multiplied payout. The Examiner continues by stating that in an analogous gaming machine, the Wilson Jr., *et al* or Adams references disclose the multiplication of a payout value (Wilson, Jr., *et al.* - Abstract; Adams- Abstract). The Examiner continues by stating that it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in the systems disclosed in the Marnell II or Farrell references because, according to the Examiner, it is well known in the art to provide multiplied payouts in slot machines to increase the players' interests in the game.

The Wilson Jr., *et al* and Adams references do not add anything to the Marnell II or Farrell references that would render the prior amendment and the arguments presented hereinabove not to be persuasive in support of patentability of amended independent claim. Accordingly, claim 13, which depends indirectly from amended independent claim 1, contains all of the limitations therein and is in allowable condition for the reasons set forth hereinabove.

### *Examiner's Response to Applicant's Remarks*

The Examiner states that Applicant argues the newly amended feature of claim 1, "the display of the image on said secondary display corresponding to a likelihood of winning the principal game", for patentability. However, it is not clear to the Examiner what Applicant means by the claim language (see above rejection). According to the Examiner, Farrell keeps track of the symbol history of the primary game by placing certain symbols from the primary game in the matrix of the secondary game. Thus, the Examiner believes that the player can predict certain "winning" patterns of the primary game by viewing the symbols placed in the secondary game matrix. Marnell II is considered by the Examiner to teach that certain poker hands (Fig. 1) or reel symbols (Fig. 2) of the primary game trigger the display of corresponding symbols in the secondary (Bingo) game.

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Thus the player is able to view the secondary game to see the winning symbols that were displayed in the primary game. The Examiner continues by stating that after viewing sections of the instant disclosure indicated by Applicant in the remarks (of the prior amendment) to show the newly added claim feature, the Examiner asserts that the systems of the Marnell II and Farrell references teach the same features as the instant claims.

The Examiner continues this aspect of the rejection by stating that Applicant argues that the Marnell II or Farrell references do not teach or suggest "any interrelationship between the principal and secondary games wherein the principal game can be won by reference to the secondary game." Applicant further argues that the Marnell II or Farrell references do not teach "a gaming machine wherein a player can earn a profit or receive an awarded that is increased in response to a secondary game... However these features are not in the claims. Applicant is reading the specification into the claims. However, the claims must recite the patentable claim features in order for Applicant to rely on the features for patentability. Therefore, the Examiner believes that as the claims are currently written and disclosed, the systems of the Marnell II or Farrell references teach all the limitations of the instant claim 1 (and claims 2-14 which depend on claim 1).

The bases by which the Examiner has maintained the prior rejection on the Marnell II or Farrell references has been addressed in detail hereinabove, and in the amendment herein to independent claim . Accordingly, for the reasons stated herein, it is respectfully asserted that all of the claims are in allowable condition.

Applicant acknowledges that the Examiner has taken notice that Applicant intends to provide a Terminal Disclaimer upon allowance of the claims, and that the double patenting rejection of claims 1-14 remains until such time.

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## *Conclusion*

The Examiner states that Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action, and accordingly, the present action was made final by the Examiner.

Applicant has provided herein a showing of support in the specification for the prior amendments, and has shown that no new matter has been sought to be entered. The arguments herein will not require further consideration or search.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the present application, allow the claims, and pass the application for issue. If the Examiner believes that the prosecution of this case can be expedited by a telephone interview, the Examiner is requested to call attorney for Applicant at the telephone number indicated hereinbelow.

Respectfully submitted,



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## Annexure 1 - Claim(s) Rewritten to Show Amendments

(Twice Amended) A gaming machine for use by a player, the gaming machine

a variable display for displaying graphical information corresponding to at least one of a plurality of graphical elements necessary for a principal game;

a controller coupled to said variable display for causing said variable display to display the graphical information; and

a secondary display having a display area for displaying a number of identical images, wherein the identical image is associated with one of a plurality of predetermined display states as a result of the principal game [for displaying an image, the image displayed by said secondary display being necessary for playing a secondary game that is different from the principal game, said secondary display displaying the image when the playing of the principal game results in one of a plurality of predetermined principal game playing states], the display of the image on said secondary display corresponding to a history of each predetermined display state of the principal game and an indication of a one of the plurality of principal game playing states that has a likelihood of winning [the] a subsequent principal game.